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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,664	04/02/2004	Anthony J. Lammers	INNODE/P0101A1	3374

29914 7590 01/24/2007
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EXAMINER

JOHNSON, JERROLD D

ART UNIT	PAPER NUMBER
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3728

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/817,664	Applicant(s) LAMMERS ET AL.	
	Examiner Jerrold Johnson	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02 April 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

The election dated 27 October 2006 is acknowledged. The restriction requirement of 11 September 2006 is currently waived in view of the presently presented claims and the prior art applied to those claims in the rejections herein.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the closed tube of claim 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,4,5,9,10,11,14,15 and 23 are rejected under 35 U.S.C. 102(b) as being rejected by Chawla US 5,560,490.

Chawla disclosed the package 2,3, article 4, and plug 5.

Re claims 4 and 5, the plug is molded into the package and the plug is affixed.

Re claim 9, the package of Chawla is a "box" within the broadest reasonable interpretation.

Re claim 10, note the blister 3, and the sheet 8, which meets the broadly claimed backing card.

Re claim 11, Chawla clearly meets this limitation.

Re claim 14, the plug 5 of Chawla meets this claim.

Re claim 15, the plug has a cone shape.

Re claim 23, the plug 5 of Chawla meets this claim.

Claim Rejections - 35 USC § 102/35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,6-8,12,13 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chawla US 5,560,490 in view of Klitzke US 3,679,146 and further in view of Examiner's Official Notice.

Chawla discloses a package having resilient plugs (col. 2, line 40), but does not disclose separately formed plugs formed of an elastomeric material affixed to the interior surface of the package.

Klitzke in Figs. 3 and 4 shows the obvious interchangeability of integrally molded plugs 23 and separately formed plugs 25, both of which are sized to fit in an opening in an article of merchandise. The plug 25 is affixed through adhesive, heat sealing, etc. (col. 2, lines 25-27) through a hole in the package as is also set forth in claim 6 of the present application.

Accordingly, it would have been obvious to one of ordinary skill in the art to recognize this interchangeability of integrally molded plugs and separately formed plugs in the package of Chawla.

With respect of the claim limitations that the separately formed plugs are affixed to the interior surface of the package, it is submitted that one of ordinary skill in the art

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would recognize that the separately formed plugs of Klitzke that are affixed to the package could have been either affixed to the interior surface or the exterior surface without a change in performance.

With respect to the plugs being formed by indentations, it is submitted that the plugs of Chawla appear to be solid, as opposed to being formed by an indentation. However, it is clear that both the integrally and separately formed plugs of Klitzke are formed as indentations. It would have been obvious to one of ordinary skill in the art to have formed the plugs of Chawla as indentations as taught by Klitzke as the hollow indentations Klitzke represent the use of a smaller amount of material than the solid plugs of Chawla, and minimizing material is generally known to be beneficial in this art.

With respect to the material of the separately formed plugs, it is submitted that plugs designed to be sealingly fit into an opening of an article are often, if not typically, molded from an elastomeric material, and the Examiner takes Official Notice of this fact. Schafer US 5,209,348 in element 50, Shaw US 3,375,920 in element 19 and Poler US 4,257,521 in element 14 all evidence this fact.

Accordingly, should one of ordinary skill in the art choose to use separately molded plugs as suggested by Klitzke, one of ordinary skill in the art would recognize the desirability of elastomeric materials in the formation of the separately molded plugs.

With respect of the claim limitations that the package has perforations (element 9 in Fig. 1 of the present application), the Examiner takes Official Notice that such a solution to open packages of this type is notoriously well known. Cox US 2,793,745 and

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Hellstrom US 3,472,368 are two references that provide evidence of this notoriously well known concept.

Accordingly, it would have been obvious to one of ordinary skill in the art to provide perforations in the package of Chawla so as to ease the opening of the package.

With respect to providing a printing legend on the proper technique for opening the package, and with respect to the backing card having perforations, the Examiner takes Official Notice that these are also a notoriously well known concept in the packaging art, a fact that is evidenced by Lehmann US 3,707,040, Denton 2,993,590, and Fisher US 4,854,450.

Accordingly, it would have been obvious to one of ordinary skill in the art to use a backing panel with a printed legend and perforations to assist the opening of the package.

Claims 2 and 22 are rejected under 35 U.S.C. 102(b) as being rejected by Chawla US 5,560,490.

With respect to the 35 U.S.C. 102(b) rejection:

Claims 2 and 22 do not set forth a specific article of merchandise as a claim element as the article of merchandise is merely set forth as the article of merchandise for which the package is intended. Accordingly, to meet this intended use limitation, it must only be evidenced that the package is inherently capable of being used with the article of merchandise set forth in the intended use limitation. In the 35 U.S.C. 102(b)

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rejection the Examiner is not burdened with a showing that it would have been obvious to one of ordinary skill in the art to use the package in this way.

The miniaturizing of items, such as pens, for novelty or even functional reasons is well known, and the Examiner takes official notice of this fact. The size and shape of the package of Chawla makes the package inherently capable of receiving a miniaturized pen.

Additional Prior Art of Record

The following prior art is herein made of record. This art has not been relied upon, but is nonetheless considered specifically pertinent to applicant's disclosure.

Park US 2002/0039511 discloses plugs in various shapes (see for instance element 200 in Fig. 4) for sealing the end of a pen.

Should the applicant amend the claims of the present application, it is the Examiner's position that the applicant should positively set forth the pen as an element in the claimed combination AND provide arguments as why one of ordinary skill in the art would not either integrally mold the plug of Park into a package or attach the plug to the package through the use of an adhesive. It is recognized that the plug of Park is intended to be removed from the pen at the initial use of the pen. Because of the extreme broad scope of the presented claims no rejection based on Park is required to be written, as the claims are drawn to a broadly set forth "article of merchandise", and Chawla is the strongest reference to reject those claims. However, were a combination claim (i.e. with the pen positively set forth) of appropriate scope be presented, a

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rejection under 35 USC 103(a) with Park as its basis would need to be used. The hypothetical rejection would be based on Park and Mason US 5,186,499 (which is exemplary of the notoriously common usage of blister packages for pens) with Chawla providing the teaching for integrating a plug into the blister so as to seal the opening in the article of merchandise. The appropriateness of such a rejection has not yet been determined. The Examiner has considered whether or not such a claim would be patentable, but has not reached a conclusion. The Applicant should contact the Examiner prior to amending the case to discuss this issue.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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